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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,359	11/03/2003	Remo Corghi	CORGHI17	1164

1444 7590 08/04/2005

BROWDY AND NEIMARK, P.L.L.C.  
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SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER
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SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/698,359

**Applicant(s)**

CORGHI ET AL.

**Examiner**

Hadi Shakeri

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 021805.
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 11 has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "centering means" renders the scope unascertainable. The specification as originally filed refers to a "self-centering" unit; it does not define the "centering means". It is unclear what elements are being claimed. While the Examiner might speculate as to what is meant by the claim language, the uncertainty provides the Examiner with no proper basis for making the comparison between that which is claimed and the prior art. Rejections under 35 U.S.C. § 103 should not be based upon considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims. *In re Steele*, 134 USPQ 292. When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 165 USPQ 494.

In light of new rules before Board of Patent Appeals and Interferences (effective September 2004) limitations or language regarding the equivalency as it relates to 35 U.S.C.

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112, 6<sup>th</sup> must meet the three-prong analysis, i.e., must use "means for" or "step for", must include function, and must not be modified by sufficient structure.

While a reasonable definition of "actuator means" is provided by the specification as originally filed, it is unclear what elements constitute the "centering means".

4. Regarding claim 2, the phrase "two actuator means" renders the scope unascertainable. There are no two means, only that the means for actuating is associated with opposing jaws. In this embodiment the "means for" includes further element, e.g., the cylinder associated with the other jaw.

5. Claim 9 recites the limitation "the holes" in line 3. There is insufficient antecedent basis for this limitation in the claim.

It is noted that Claim 11 recites the limitation "the holes" in line 5 lacking sufficient antecedent basis. Is claim depending on 5 or 7? 11/5 lacks sufficient antecedent basis.

### ***Claim Rejections - 35 USC § 103***

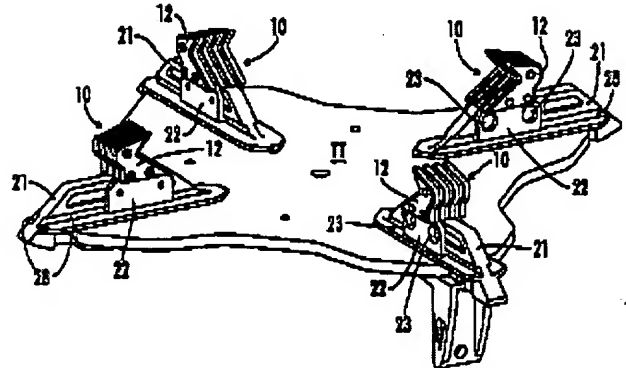
6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3 and 13 (as best understood) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cunningham et al. (6,062,289).

Cunningham et al. discloses all of the limitations of claim 1 (as best understood), i.e., a plate with a series of equidistant radial slots in each of which a clamping jaw (10) is received and slides to grip the edge of a wheel rim, said clamping jaws being linked together in such a manner as to be always equidistant from the axis of said plate, at least one clamping jaw being associated with actuator means (Fig. 1) causing it to translate in a radial direction, and further comprising between said at least one clamping jaw and said actuator means there a positioner device (21, 22, 24, 26, 28 and 25) arranged to vary the working position of said at least one clamping jaw without modifying the travel stroke.



Regarding claims 2, 3 and 13, Cunningham et al. meets the limitations, i.e., the cylinder piston actuation means being connected to two jaws each having a positioner device (Fig. 1).

In the alternative, Cunningham et al. is silent regarding the actuation of jaws. Moving the jaws in unison and/or "self-centering jaws" are known in the art as evident by Schmidt, du Quesne, Feldmann et al., or Wuesthoff. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Cunningham et al. with "self-centering" jaws as taught by anyone of Schmidt, du Quesne, Feldmann et al., or Wuesthoff to enhance the operation.

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

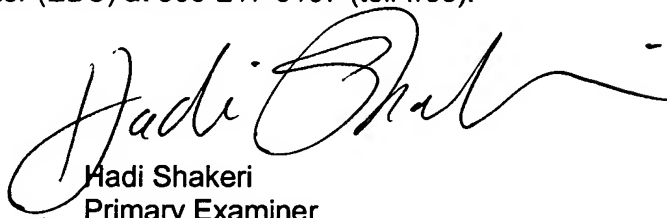
***Response to Arguments***

9. Applicant's arguments with respect to claim 1 (as best understood) have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri  
Primary Examiner  
Art Unit 3723  
August 2, 2005